

74

Notice of Allowability

Application No.

10/789,323

Examiner

Yevgeny Valenrod

Applicant(s)

STAPPER ET AL.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to applicants' election.
2. ☒ The allowed claim(s) is/are 1-10,12-14,16 and 17.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.


Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 20060825.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

DETAILED ACTION

Election Restriction

Applicant's election without traverse of Group I (Claims 1-5 in part, and 6-10) in the reply filed on 7-28-2006 is acknowledged.

Claims 1-10 directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), claims 11-17, directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, **the restriction requirement of groups I and VII as set forth in the Office action mailed on 6-02-2006 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claims including all the limitations of an allowable product claim or rejoined process claim are presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Allowance

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Barbara Kurys on 8-25-2006. (See Examiner initiated interview summary)

Examiners Amendment

Claim 1

- Amend lines 4-6 of claim 1 to read: "ring A is (C3-C8)-cycloalkanediyl or (C3-C8)-cucloalkenediyl;" Delete everything else in lines 4-6 of claim 1.
- Amend lines 8-10 of claim 1 to read: "R is NR1R2 or OR1;" Delete everything else in lines 8-10 of claim 1.

Claim 2

- Amend line 3 (counting only printed lines) of claim 2 to read: "R is NR1R2;" Delete everything else in line 3 of claim 2.

Claim 3

Art Unit: 1621

-Amend line 3 (counting only printed lines) of claim 3 to read: "R is NR1R2;"

Delete everything else in line 3 of claim 3.

Claim 4

-Amend line 3 (counting only printed lines) of claim 4 to read: "R is NR1R2;"

Delete everything else in line 3 of claim 4.

Cancel claim 11.

Claim 13

Amend claim 13 to read: " A method of treating diabetes mellitus and sequelae associated therewith comprising administering to a patient in need thereof a therapeutically affective amount of compound of formula 1.

Cancel claim 15.

Reason for allowance

The following is an examiner's statement of reasons for allowance: The compound of formula (I), limited to the scope of the elected Group I was found to be novel. Closest art (EP 0 293 880 A1) discloses a compound (page 2) that most closely resembles the compound of the instant invention. The two generic structures are similar however the differences between them are not obvious. The difference is in the substitution of the benzene ring that is connected to "Y".

Art Unit: 1621

The instantly claimed compound is very specific about having a CO₂R₄ group in 2-position and a methyl group in the 3-position. The reference does provide for substitution of the same ring (Ar' in reference), it fails to list a carboxylate group as one of the substituents and does not specify any specific ring positions to be substituted. The substitution as described in the instant claims is therefore not obvious over (EP 0 293 880 A1).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on Mon-Fri from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on Mon-Fri 9am to 7pm. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

Art Unit: 1621

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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